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In re Application of :
WECHNER, Edward :
U.S. Application No. 10/050,679 :
PCT No.: PCT/AU01/00560 :
Int. Filing Date: 16 May 2001 :
Priority Date: 09 June 2000 :
Attorney Docket No.: 5610 :
For: FREE-PISTON INTERNAL :
COMBUSTION ENGINE WITH VALVES
LOCATED IN PISTONS

DECISION

This decision is in response to applicants' "Request for Change of Filing Status From U.S. Non-Provisional Application to U.S. National Stage Application" filed 03 November 2003. The initial papers filed 15 January 2002 were processed as a filing under 35 U.S.C. 111(a). For the reasons discussed below, the application will be converted to a national stage filing of PCT/AU01/00560.

BACKGROUND

On 16 May 2001, applicant filed international application PCT/AU01/00560 which claimed a priority date of 09 June 2000. A Demand was filed with the International Preliminary Examining Authority prior to the expiration of 19 months from the priority date, and as a result the deadline for payment of the basic national fee was extended to expire 30 months from the priority date, i.e., 09 December 2002.

On 15 January 2002, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee; a small entity statement; and a copy of the international application. The application was processed as a filing under 35 U.S.C. 111(a).

On 03 November 2003, applicant filed Request for Change of Filing Status From U.S. Non-Provisional Application to U.S. National Stage Application;" "Declaration to Unintentional Error in Claiming Priority to Australian Provisional Instead of Australian Non-Provisional Application;" and "Acceptance of an Unintentionally Delayed Claim for Priority."

On 29 June 2004, applicant filed a supplemental declaration and power of attorney.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or

2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

As noted above, applicant's original transmittal letter, filed 15 January 2002, specifically identified the accompanying submission as a submission to enter the national stage under 35 U.S.C. 371. No contradictory instructions were submitted. Therefore, the application papers filed 15 January 2002 should have been processed under 35 U.S.C. 371, not 35 U.S.C. 111.

Accordingly, the filing receipt issued on this application, which did not indicate filing under 35 U.S.C. 371, was in error and is hereby vacated. It is noted that the declaration submitted on 15 January 2002 was not in compliance with 37 CFR 1.497(a)(3) which requires that the oath or declaration identify each inventor and the residence and country of citizenship of each inventor.

The supplemental declaration filed on 29 June 2004 is in compliance with 37 CFR 1.497(a)(3) and 35 U.S.C. 371(c)(4).

The petition for "Acceptance of an Unintentionally Delayed Claim for Priority" is not necessary and dismissed as moot. The \$1330 petition under 37 CFR 1.78 will be refunded to Deposit Account no. 10-0210.

CONCLUSION

For the reasons above, the application will be converted from a 35 U.S.C. 111 filing to a national stage application under 35 U.S.C. 371.

This application has an international filing date of 16 May 2001 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of 29 June 2004.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision, that is, for mailing of a Notification of Acceptance of Application (Form PCT/DO/EO/903) and Official Filing Receipt which identifies this application as a national stage application of PCT/AU01/00560.

Thereafter, the application will be forwarded to Art Unit 3747.



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